REMARKS

By this amendment, claims 1, 2, 7, 8 and 12-16 remain cancelled. Claims 3, 5, 9 and 17 have been amended. Claims 3-6, 9-11 and 17 remain in the application. This application has been carefully considered in connection with the Examiner's Action. Reconsideration and allowance of the application, as amended, is respectfully requested.

Rejection under 35 U.S.C. § 103

As presented herein, claims 3, 5 and 17 have been amended to further clarify and distinguish the present claimed method, apparatus, and computer readable medium for automatically updating data elements in a form document being used by a first software application. The claims require the accessing of <u>data elements</u> stored in a common database. The <u>accessed data elements</u> correspond to data elements used in a form document by a first software application. The <u>data elements</u> of the common database include not only the accessed data elements for use by the first software application, but also additional data elements, wherein various of the data elements of the database can be common to more than one <u>different form documents</u> of more than one <u>different software applications</u> having access to the common database. In other words, the data elements can be common, whereas the software applications are not necessarily common software applications. See, for example, the specification on page 14, lines 13-15. In addition, each data element includes at least <u>(i)</u> a field and <u>(ii)</u> data in the field. As discussed in the specification on page 8, lines 8-10, a data element can include, for example, <u>(i)</u> a "last name" and a "telephone number" field and <u>(ii)</u> a last name and telephone number entry in the field. Accordingly, with this explanation and the claims as now presented, the claim language should be more easily understood by themselves, in contrast to the cited art.

Claims 3-6, 9, 10 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beizer et al. (US 6240414) ("**Beizer**") in view of Bhansali et al. (US 6006239) ("**Bhansali**"). (*It is noted that on page 2 of the Office Action, the rejection reads "Claims 3-6, 9, 11 and 17"; however, on page 8 of the Office Action, the first paragraph refers to Claim 10. It appears that the "11" is a typographical error and so the following includes remarks addressed to claim 10, instead of claim 11.*) With respect to claims 3, 5 and 17, applicant respectfully traverses the rejection on the grounds that these references are defective in establishing a prima facie case of obviousness.

> As the PTO recognizes in MPEP § 2142:
> *... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, a prima facie case of obviousness has not been factually supported for the at least the following, mutually exclusive, reasons.

1.   Even When Combined, the References Do Not Teach the Claimed Subject Matter

The Beizer and Bhansali patents cannot be applied to reject claims 3, 5 and 17 under 35 U.S.C. § 103 which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ...* (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. Neither Beizer nor Bhansali teaches accessing data elements stored in a common database that correspond to the form document being used by the first software application, wherein the data elements of the database can be common to more than one different form documents of more than one different software

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applications having access to the common database ... , wherein the rules are based upon (I) a characteristic of the change to the accessed data elements by the second software application, wherein the characteristic of the change comprises the accessed data elements having been electronically signed by the second user in which the electronically signed data elements require a password to edit the corresponding data elements, and (II) a characteristic of the accessed data elements used by the first software application, wherein the characteristic of the accessed data elements comprises (i) a change to a field of the accessed data elements while the form document has remained open by the first software application, (ii) fields of the accessed data elements having been updated from the common database while the form document has remained open by the first software application, (iii) fields of the accessed data elements that have not changed since the form document was opened by the first software application, and (iv) the accessed data elements having been electronically signed by the first user in which the electronically signed data elements require a password to edit the corresponding data elements, all as is claimed in claim 3, 5 and 17.

In contrast, Beizer teaches editing of a workfolder and using a reconciliation program to compare a version of a most recently saved local copy workfolder to a master version of the workfolder on a server, but does not teach or suggest the specific rules as in claims 3, 5 and 17. In addition, Bhansali teaches a method for allowing multiple users to simultaneously edit a common spreadsheet. Bhansali further teaches a session ID that allows each user to determine whether another user has performed a save operation since the time that user last accessed the spreadsheet and performed a save operation. (See Bhansali at Column 8, lines 12-15). In other words, the session ID of Bhansali identifies the particular version of the spreadsheet, and the session ID is thus not a password for editing of electronically signed data elements. In addition, no reference to a password is found in Bhansali at column 8, lines 7 to column 9, line 31.

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Accordingly, Bhansali does not teach or suggest the specific rules as in claims 3, 5 and 17.

Therefore, it is impossible to render the subject matter of claims 3, 5 and 17 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. The Combination of References is Improper

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly <u>not</u> the case based on the above), there is still another, mutually exclusive, and compelling reason why the Beizer and Bhansali patents cannot be applied to reject claims 3, 5 and 17 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

> ...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither Beizer nor Bhansali teaches, or even suggests, the desirability of the combination since neither teaches the <u>specific</u> combination that includes, wherein the rules are based upon (I) a characteristic of the change to the accessed data elements by <u>the second software application</u>, wherein the characteristic of the change comprises the accessed data elements having been electronically signed by the second user in which the electronically signed data elements require a password to edit the corresponding data elements, and (II) a characteristic of the accessed data elements used by the first <u>software application</u>, wherein the characteristic of the accessed data

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elements comprises (i) a change to a field of the accessed data elements while the form document has remained open by the first software application, (ii) fields of the accessed data elements having been updated from the common database while the form document has remained open by the first software application, (iii) fields of the accessed data elements that have not changed since the form document was opened by the first software application, and (iv) the accessed data elements having been electronically signed by the first user in which the electronically signed data elements require a password to edit the corresponding data elements, as specified above and as claimed in claims 3, 5 and 17.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

> *The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

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In the present case it is clear that the combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 3, 5 and 17. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claims 3, 5 and 17 are allowable and an early formal notice thereof is requested. Dependent claims 4 and (6, 9 and 10) depend from and further limit, in a patentable sense, independent claims 3 and 5, respectively, and therefore are allowable as well.

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Beizer et al. (US 6240414)("**Beizer**") in view of Bhansali et al. (US 6006239) ("**Bhansali**"), further in view of Sugano et al. (US 6205478) ("**Sugano**"). Applicant respectfully traverses this rejection for at least the following reasons. Claim 11 depends from and further limits, in a patentable sense, allowable independent claim 5 and therefore is allowable as well.

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Conclusion

It is clear from all of the foregoing that independent claims 3, 5 and 17 are in condition for allowance. Dependent claims (4) and (6, 9 - 11) depend from and further limit independent claims 3 and 5, respectively, therefore are allowable as well. The amendments herein are fully supported by the original specification and drawing, therefore, no new matter is introduced (see for example, page 8, lines 8-10; and page 14, lines 13-15). Issuance of an early formal notice of allowance of claims 3-6, 9-11 and 17 is requested.

Respectfully submitted,

Michael J. Balconi-Lamica
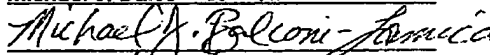Registration No. 34,291

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21004 Lakeshore Dr. W.
Spicewood, Texas 78669
Telephone: 512-461-2624
Facsimile: 512-264-3687
File: US010383

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